

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JON A. WOLFF AND VLADIMIR G. BUDKER

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Application No. 09/707,000

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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was received electronically at the Board of Patent Appeals and Interferences on June 14, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below:

Appellants filed an Appeal Brief on September 22, 2005. The brief is not in compliance with the new rules under 37 CFR § 41.37, effective September 13, 2004.

37 CFR § 41.37 states:

(c)(1) The brief will contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

(i) *Real party in interest.* A statement identifying by name the real party in interest.

(ii) *Related appeals and interferences.* A statement identifying by application, patent, appeal or interference number all other prior and

pending appeals, interferences or judicial proceedings known to appellant, the appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal. Copies of any decisions rendered by a court or the Board in any proceeding identified under this paragraph must be included in an appendix as required by paragraph (c)(1)(x) of this section.

(iii) *Status of claims.* A statement of the status of all the claims in the proceeding (e.g., rejected, allowed or confirmed, withdrawn, objected to, canceled) and an identification of those claims that are being appealed.

(iv) *Status of amendments.* A statement of the status of any amendment filed subsequent to final rejection.

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

(vi) *Grounds of rejection to be reviewed on appeal.* A concise statement of each ground of rejection presented for review.

(vii) *Argument.* The contentions of appellant with respect to each ground of rejection presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on. Any arguments or authorities not included in the brief or a reply brief filed pursuant to § 41.41 will be refused consideration by the Board, unless good cause is shown. Each ground of rejection must be treated under a

separate heading. For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately. Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.

(viii) *Claims appendix*. An appendix containing a copy of the claims involved in the appeal.

(ix) *Evidence appendix*. An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) *Related proceedings appendix*. An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

Note particular examples of discrepancies in the brief in the instant application as per the section heading are:

1. Appellants heading "SUMMARY OF INVENTION" should be § 41.37 heading "(v) *Summary of claimed subject matter*", and contain the appropriate content;
2. Appellants heading "ISSUES" should be § 41.37 heading "(vi) *Grounds of rejection to be reviewed on appeal*";
3. Appellants' heading "GROUPING OF CLAIMS" should be deleted and incorporated into the § 41.37 heading "(vii) *Argument*";
4. The minor errors in the "(viii) *Claims Appendix*" noted by the examiner the examiner's answer should be corrected and
5. The appendices "(ix) *Evidence Appendix*" and "(x) *Related Proceedings Appendix*" are missing from the brief and should be added.

**Note: The 1.132 Wolff Declaration filed June 16, 2004 should be listed and a copy included in the Evidence Appendix**

All of the requisite headings and appendices noted above are to be placed within appeal briefs filed under 37 CFR § 41.37, (whether or not there is any matter relative to these headings) with "None" or similar text indicating that there is none placed beneath the heading that is the case.

A substitute brief properly filed under the new rules as per the new rules under 37 CFR § 41.37 is required. For more information, see the United States Patent and Trademark website [www.uspto.gov](http://www.uspto.gov), and, in particular, the web page entitled "More

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Information on the Rules of Practice Before the Board of Patent Appeals and Interferences, Final Rule" located at the following URL:

[www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html](http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html)

Correction is required.

Additionally, we find no evidence in any subsequent action by the examiner that the Wolff Declaration filed June 16, 2004, has been considered by the examiner.

Correction is required.

Accordingly, it is

ORDERED that the application is returned to the Examiner:

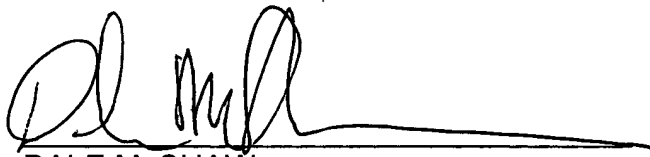
- a.) to hold the Appeal Brief filed September 22, 2005, defective and notification to appellants to file a substitute Appeal Brief in compliance with the new rules under 37 CFR § 41.37 as noted above;
- b.) for consideration of the substitute Appeal Brief;
- c.) if necessary issue a revised Examiner's Answer in response to the substitute Appeal Brief;

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- d.) for proper consideration of the Wolff Declaration filed June 16, 2004; and
- e.) for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

By:

A handwritten signature in black ink, appearing to read 'D M Shaw', with a long horizontal line extending to the right.

DALE M. SHAW  
Deputy Chief Appeals Administrator  
(571) 272-9797

DMS/vsh

cc: MIRUS CORPORATION  
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